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| 10/024,351      | 12/21/2001  | Gilles Rubinstenn    | 05725.1009-00       | 4841             |

7590 03/12/2004

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| EXAMINER |
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BORISSOV, IGOR N

| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/024,351

**Applicant(s)**

RUBINSTENN ET AL.

**Examiner**

Igor Borissov

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

**Claim 26** is objected to because of the following informalities:

The examiner wonders if **claim 26** should really depend on **claim 25** or **claim 28**.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-10 and 24-30 are rejected under 35 U.S.C. 101** because the claimed beauty diagnostic method does not recite a limitation in the technological arts. The independently claimed steps of: "Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject; receiving answers to the personal questions; based on the received answers, selecting a customized set of testing material; and informing the subject about said customized set of testing material" are abstract ideas which can be performed mentally without interaction of a physical structure. The method step: "selecting a customized set of testing material" may be understood as merely obtaining an advise from a beauty consultant in a beauty store. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1-25 and 28-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Maloney et al. (WO 01/18674 A2).**

Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising:

**Claim 1.** Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30); receiving answers to the personal questions (page 11, lines 26-27); based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material (page 11, lines 7-9); informing the subject about said at least one customized set of testing material (page 11, lines 13-14).

**Claim 2.** Providing the subject with the customized set of testing material (page 11, lines 13-14).

**Claim 3.** See claim 2.

**Claim 4.** Ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20).

**Claim 5.** Recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

**Claim 6.** Said method and system, wherein the customized set of testing material includes at least one of a pH indicator, sebutape, and a corneodisque indicator (page 11, lines 11-12).

**Claim 7.** Said method and system, wherein the questions are posed to the subject over a computer network (page 8, line 35 – page 9, line 2), and wherein

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the at least one customized set of testing material is delivered to the subject via a courier (column 11, line 18).

**Claim 8.** Maintaining an inventory of a plurality of different groups of customized sets of testing material (page 10, lines 4-5).

**Claim 9.** See claim 2.

**Claim 10.** See claim 2.

**Claim 11.** See claim 1.

**Claim 12.** See claim 2.

**Claim 13.** See claim 4.

**Claim 14.** See claim 5.

**Claim 15.** See claim 6.

**Claim 16.** See claim 7.

**Claim 17.** See claim 8.

**Claim 18.** See claim 9.

**Claim 19.** See claim 10.

**Claim 20.** See claim 1.

**Claim 21.** See claim 2.

**Claim 22.** See claim 4.

**Claim 23.** See claim 5.

**Claim 24.** Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30); receiving answers to the personal questions (page 11, lines 26-27); based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material (page 11, lines 7-9); providing the subject with the customized set of testing material (page 11, lines 13-14); ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20); recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

**Claim 25.** See claim 1.

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**Claim 28. See claim 16.**

**Claim 29. See claim 2.**

**Claim 30. See claim 6.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of in view of Rigg (US 6,293,284).**

As per **claims 26 and 27**, Maloney teaches all the limitations of **claims 26 and 27**, except specifically teaching that said information is an image of the external body condition.

Rigg teaches virtual makeover method and system, wherein a picture of the consumer is transmitted to a consultant at a remote location, and wherein said consultant can then provide further customized product-related information to said consumer (column 2, line 49 - column 3, line 7)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said information is an image of the external body condition, because the digital scan would provide the most accurate determination of natural skin color, thereby resulting in consultant's best recommendations.

***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

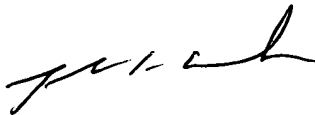
***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451  
Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

DB

  
**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**